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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
WESTERN DIVISION – FIRST STREET

INTUITIVE IMAGING INFORMATICS,  
LLC, a Nevada limited liability company,

Plaintiff and Counter-  
Defendant,

v.

INTUITIVE SURGICAL OPERATIONS,  
INC., a Delaware corporation, et al.,

Defendants and Counter-  
Claimants.

AND RELATED COUNTERCLAIMS

CASE NO. 2:23-cv-10593-DSF-RAO

Honorable Dale S. Fischer

**DEFENDANTS' OPPOSITION TO  
PLAINTIFF'S MOTION FOR  
LEAVE TO FILE FIRST  
AMENDED COMPLAINT**

Date: August 26, 2024  
Time: 1:30 p.m.  
Location: Courtroom 7D

Filing Date: 12/18/2023  
Trial Date: 12/09/2025

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1 Defendants Intuitive Surgical Operations, Inc., Intuitive Surgical, Inc.,  
 2 Intuitive Surgical Holdings, LLC, Intuitive Fluorescence Imaging, LLC, and  
 3 Intuitive Surgical Service Optics, Inc. (collectively, “Defendants”) respectfully  
 4 submit this Memorandum in Opposition to the Motion of Plaintiff Intuitive  
 5 Imaging Informatics, LLC (“Plaintiff”) to File Its First Amended Complaint (the  
 6 “Motion”).

## 7 **I. Introduction**

8 While the Federal Rules state that leave to amend should be “freely given  
 9 when justice so requires,” Fed. R. Civ. P. 15(a), this is not such a case. Indeed,  
 10 given that Plaintiff refused to engage in the mandatory L.R. 7-3 conference prior to  
 11 rushing to file its motion and did not follow this Court’s rules in any event,  
 12 Plaintiff should be required to proceed as the local rules and those of this Court  
 13 require. In any event, it would be unjust to permit Plaintiff to amend its  
 14 Complaint, because Plaintiff appears to be using the amendment procedure for  
 15 purposes of delay, including to force Defendants to respond repetitively to the  
 16 same baseless allegations and to defer the determination of Defendants’ pending  
 17 Motion for Judgment on the Pleadings—even though Plaintiff has conceded that its  
 18 amendments do not moot such motion.

19 As set forth below, Plaintiff’s amendments with respect to its newly added  
 20 defendants are dilatory, given that it should have been on notice of those  
 21 defendants’ existence for the past four years. Additionally, Plaintiff’s amendments  
 22 are generally futile, as its attempt to assert a new cause of action amounts to  
 23 nothing more than a restatement of an existing cause of action, and Plaintiff fails to  
 24 add any substantive allegations that support its case or address the points raised in  
 25 Defendants’ Motion for Judgment on the Pleadings. These issues, paired with  
 26 Plaintiff’s delay in presenting Defendant with a copy of its proposed amendments  
 27 and failing to engage in a meaningful conference with Defendant prior to the filing  
 28

1 of its Motion, indicate that Plaintiff has not filed its Motion in good faith.

2 Therefore, Plaintiff's request should be denied.

## 3 **II. Factual Background**

4 As set forth in other briefing before the Court, the parties' dispute began in  
 5 2022, after the USPTO preliminarily refused to register one of Defendants'  
 6 trademark registrations due to a perceived conflict with the registrations for  
 7 Plaintiff's "Intuitive Imaging Informatics" mark and related design mark (the "I3  
 8 Marks"). Defendant Intuitive Surgical Operations, Inc. ("ISO") filed a petition to  
 9 cancel the registrations for the I3 Marks with the Trademark Trial and Appeal  
 10 Board, primarily on the ground of abandonment. *See* Compl. ¶¶ 31-33; *see also*  
 11 Intuitive Surgical Operations, Cancellation No. 92080980, Dkt. No. 1. During the  
 12 cancellation proceeding, Plaintiff did not produce any evidence that it used the I3  
 13 Marks in commerce at any point in the last ten years, filed a motion to compel  
 14 responses to requests on issues not in the case and thereby triggered a stay of  
 15 Defendants' ability to file a motion to compel, and stonewalled ISO's numerous  
 16 requests to conduct a Rule 30(b)(6) deposition of Plaintiff. *See* Countercl. ¶¶ 66-  
 17 73; Reply ¶¶ 66-73.

18 On December 18, 2023, in an apparent effort to extract an unwarranted  
 19 payment for its abandoned I3 Marks and avoid a Rule 30(b)(6) deposition, and  
 20 despite admitting no actual confusion, Plaintiff initiated this lawsuit against  
 21 Defendants. In its Complaint, Plaintiff asserts five claims for relief: (1)  
 22 infringement of federally registered trademarks in violation of the Lanham Act; (2)  
 23 unfair competition in violation of the Lanham Act; (3) common law trademark  
 24 infringement and unfair competition; (4) unlawful, unfair, or fraudulent business  
 25 acts or practices in violation of Cal. Bus. & Prof. Code § 17200 *et seq.* (known as  
 26 "California Unfair Competition Law" or "UCL"); and (5) trademark infringement  
 27 in violation of Cal. Bus. & Prof. Code §§ 14245 & 14250.

Defendants filed a Motion for Judgment on the Pleadings on June 28, 2024. *See* Dkt. No. 54. Among other things, Defendants’ Motion for Judgment on the Pleadings pointed out that Plaintiff’s Complaint is an impermissible “shotgun pleading,” that Plaintiff’s Lanham Act and state law claims are time-barred, and that Plaintiff cannot assert a trademark infringement claim under California law because Plaintiff does not own any trademarks that are registered with California. Two weeks after the Motion for Judgment on the Pleadings was filed, Plaintiff’s counsel, Edward Saadi, asked to adjourn the August 12, 2024 hearing on the Motion, citing a family vacation on that date. *See* Declaration of Eleanor Lackman, at ¶ 4. Defendants’ counsel, Eleanor Lackman, agreed to adjourn the hearing, noting the fact that it would require a change of her own travel plans at some cost. *Id.* The hearing on Defendants’ Motion for Judgment on the Pleadings now is currently set for August 26, 2024, and although Defendants indicated that no other dates be changed, Plaintiff (via a proposed stipulation that counsel represented reflected their agreement) received by rule an extra two weeks for opposition, which is now due on August 5, 2024. *Id.* ¶ 5.

One week later, on July 19, 2024, Mr. Saadi first alerted Ms. Lackman that he intended to seek leave to file an amended complaint “adding a claim for relief for reverse confusion, and also adding Orpheus Medical as a defendant.” *Id.* ¶ 6, Ex. A. Mr. Saadi proposed that if Defendants intended to oppose, the hearing could be set for August 26, 2024, leaving a very tight window for response. *Id.* Nonetheless, Ms. Lackman responded to Mr. Saadi on the same day, requesting to review a copy of the complaint so that she could return to him with a position on whether she would stipulate to that amendment. *Id.* ¶ 7, Ex. A.

On July 22, 2024, Mr. Saadi responded to Ms. Lackman and, contrary to his prior position, suggested that she simply stipulate to the amendment of the Complaint, withdraw Defendants’ Motion for Judgment on the Pleadings, and re-

1 file Defendants’ Motion after service of the amended complaint. *Id.* ¶ 8, Ex. A.  
 2 Ms. Lackman replied that she could not opine on a complaint that she had not yet  
 3 seen, particularly where the substance of the amended complaint sounded largely  
 4 identical to the original defective complaint, and where Plaintiff seemed to be  
 5 seeking to add a party based outside of the United States. *Id.* ¶ 9, Ex. A.

6 Mr. Saadi did not forward a draft of the amended complaint until Friday,  
 7 July 26, 2024, the last business day before Plaintiff’s deadline to file its Motion,  
 8 and did not forward a redline that identified the proposed amendments until  
 9 Sunday, July 28, 2024 at 10:38 p.m., when Mr. Saadi sent a Word version of the  
 10 proposed amended complaint that did not clearly highlight the substantive  
 11 amendments. *Id.* ¶ 10, Ex. A. Once a proper redline was able to be run the next  
 12 morning, the redline revealed that the proposed amendment names *two* entities that  
 13 share the name “Orpheus Medical,” expands the first cause of action to now recite  
 14 two purported trademark causes of action, including claims of forward and reverse  
 15 confusion, and adds additional allegations not referenced in any prior  
 16 correspondence.<sup>1</sup> *Id.* ¶ 11, Ex. B (redline excerpts reflecting changes in Plaintiff’s  
 17 proposed First Amended Complaint). That same day, on July 29, 2024, Ms.  
 18 Lackman asked for Mr. Saadi’s availability for an L.R. 7-3 conference, so that the  
 19 parties could discuss the amendments. *Id.* ¶ 12, Ex. A. Four hours later, Mr. Saadi  
 20 responded that the parties had already “been emailing about [the amended  
 21 complaint],” noted that the deadline for Plaintiff’s Motion had come<sup>2</sup> and, one

22  
 23  
 24 <sup>1</sup> It is worth mentioning that, when Defendants were preparing to file their Motion  
 25 for Judgment on the Pleadings, they provided—at Plaintiff’s insistence—a  
 significant number of details in response to Plaintiff’s questions about the  
 substance of their motion. Lackman Decl., ¶ 2.

26 <sup>2</sup> Tellingly, Plaintiff has never proposed that the parties stipulate to an adjustment  
 27 of the deadline for its Motion. If Plaintiff understood that this deadline was  
 imminent following the filing of Defendants’ Motion, it should have raised its  
 request with adequate time for Defendants to review its proposed amendments and  
 28 to engage in a meaningful discussion.



1 minute after responding declining the request to confer, filed Plaintiff's Motion.  
 2 *Id.* ¶ 12, Ex. A.

3 The parties finally held an L.R. 7-3 conference on August 1, 2024, *after*  
 4 Plaintiff's Motion was filed. *Id.* ¶ 13. Plaintiff did not withdraw its Motion prior  
 5 to agreeing to the conference, leaving Defendants with no choice but to oppose  
 6 within the short window provided.

### 7 **III. Legal Standard**

8 Leave to amend, while liberally construed, is not without limitation. The  
 9 Supreme Court has identified numerous reasons where leave should be denied,  
 10 including "undue delay, bad faith or dilatory motive on the part of the movant,  
 11 repeated failure to cure deficiencies by amendments previously allowed, undue  
 12 prejudice to the opposing party by virtue of allowance of the amendment, futility  
 13 of amendment, etc." *Foman v. Davis*, 371 U.S. 178, 182 (1962) (noting that the  
 14 "grant or denial of an opportunity to amend is within the discretion of the District  
 15 Court"); *Allen v. City of Beverly Hills*, 911 F.2d 367, 373 (9th Cir. 1990). A  
 16 district court may find one factor or a combination of factors sufficient to deny  
 17 leave to amend. *In re Cir. Breaker Litig.*, 175 F.R.D. 547, 550 (C.D. Cal. 1997).

18 As discussed in detail below, Plaintiff's Motion fails on the above-  
 19 mentioned grounds and should be denied.

### 20 **IV. Argument**

21 Plaintiff's proposed amendments fail to cure the original complaint of its  
 22 original defects. The amendments name new defendants, but provide no  
 23 substantive allegations with respect to those entities, attempt to state a new cause  
 24 of action that only reframes an existing cause of action, and try to demonstrate that  
 25 Plaintiff can state a claim for trademark infringement under California law with a  
 26 single non-sequitur. *See* Lackman Decl., Ex. B. Nothing productive will come  
 27 from allowing Plaintiff to make its proposed amendments in a fatally flawed suit,

1 particularly where a Motion for Judgment on the Pleadings is already pending and  
 2 Plaintiff's Motion has ostensibly been filed with an eye towards delaying the  
 3 determination of Defendants' Motion for Judgment on the Pleadings. The  
 4 existence of a counterclaim only compounds the scheduling hiccups. The Court  
 5 should reject Plaintiff's bad-faith attempt to defer the determination of the  
 6 unsupported merits of its case, and deny Plaintiff's Motion.

### 7 **1. Plaintiff's Proposed Amendments Are Dilatory**

8 Plaintiff seeks to amend the Complaint in order to, among other things, add  
 9 Orpheus Medical Ltd. and Orpheus Medical USA, Inc. (collectively, "Orpheus") as  
 10 defendants. Given that Defendants' acquisition of Orpheus occurred four years  
 11 ago,<sup>3</sup> Plaintiff likely knew or should have known of Orpheus well before the filing  
 12 of the Complaint, and had no reason to delay the addition of those entities to this  
 13 lawsuit. Where a party seeking amendment knows or should know of the facts  
 14 upon which the proposed amendment is based but fails to include them in the  
 15 original complaint, the motion to amend may be denied. *Jordan v. Los Angeles*  
 16 *Cnty.*, 669 F.2d 1311, 1324 (9th Cir.1982), *judgment vacated on other grounds*,  
 17 *Cnty. of Los Angeles v. Jordan*, 459 U.S. 810 (1982).

18 Furthermore, Plaintiff's amendments provide no substantive allegations with  
 19 respect to the alleged acts or omissions of Orpheus, much less an explanation as to  
 20 why those entities should be added at this juncture. Indeed, Plaintiff  
 21 disingenuously claims that they are two of the "Does" and speculates in its motion  
 22 (Dkt. 68 at 4) that the Israeli entity could be engaging in infringement, while  
 23 saying nothing about why Orpheus Medical USA, Inc. is named. Plaintiff states  
 24 that it has "now learned" of the acquisition of Orpheus, but provides no rationale as  
 25 to why it has only just now gained this awareness, given that no relevant

26  
 27 <sup>3</sup> See Intuitive Acquires Orpheus Medical to Expand Informatics Platform for  
 28 Hospitals (Feb. 10, 2020), [https://isrg.intuitive.com/news-releases/news-release-  
 details/intuitive-acquires-orpheus-medical-expand-informatics-platform](https://isrg.intuitive.com/news-releases/news-release-details/intuitive-acquires-orpheus-medical-expand-informatics-platform).

1 circumstances have changed over the past four years and Plaintiff has served no  
 2 discovery relating to Orpheus. When pressed during the parties' L.R. 7-3  
 3 conference, Plaintiff's counsel declined to state whether Plaintiff had become  
 4 aware of some specific facts relating to Orpheus' alleged infringement. Lackman  
 5 Decl., ¶ 13. Suffice it to say, this lack of diligence in raising the parties, on top of  
 6 Plaintiff's failure to justify the inclusion of Orpheus on a "shotgun pleading" basis  
 7 where Plaintiff's Prayer for Relief already seeks injunctive relief against a wide  
 8 array of parties related to Defendants, supports a denial of Plaintiff's Motion.

## 9 **2. Plaintiff's Proposed Amendments Are Futile**

10 "Futility of amendment can, by itself, justify the denial of a motion for leave  
 11 to amend." *Bonin v. Calderon*, 59 F.3d 815, 845 (9th Cir. 1995). Here,  
 12 Defendants' Motion for Judgment on the Pleadings comprehensively set forth the  
 13 reasons why Plaintiff's action, including the proposed amended trademark  
 14 infringement claim, is barred as a matter of law. *See* Dkt 54. As Plaintiff itself  
 15 acknowledges in its Motion, its proposed amendments do not substantively alter  
 16 the existing allegations of the Complaint.<sup>4</sup> *See* Dkt. 68 at 2. Plaintiff's Motion  
 17 fails to raise *any* amendments that would address the issues identified in  
 18 Defendants' Motion for Judgment on the Pleadings, and therefore should be  
 19 denied. *Compare to McZeal v. Amazon Servs., LLC*, No. 221CV07093SVWRAO,  
 20 2021 WL 5213099, at \*6 (C.D. Cal. Nov. 8, 2021) (declining to grant leave to  
 21 amend complaint because the plaintiff could not, as a matter of law, state a claim  
 22 for trademark violation).

23 Plaintiff's amendments regarding its trademark infringement claim are futile.  
 24 Plaintiff attempts to reframe its first cause of action for trademark infringement by  
 25 separating it into two causes of action – one for "forward confusion" and another

26 <sup>4</sup> Plaintiff's counsel also conceded during the parties' L.R. 7-3 conference that the  
 27 changes in the proposed First Amended Complaint would not moot the issues  
 28 raised in Defendants' Motion for Judgment on the Pleadings regarding the merits  
 of Plaintiff's claims. Lackman Decl., ¶ 13.

1 for “reverse confusion.” This distinction does not add anything new to Plaintiff’s  
 2 causes of action: while trademark infringement is a cause of action under the  
 3 Lanham Act, “confusion” does not constitute a cause of action. *See, e.g.*, 15  
 4 U.S.C. § 1114 (providing a cause of action for infringement of registered  
 5 trademarks); *Murray v. Cable Nat. Broad. Co.*, 86 F.3d 858, 861 (9th Cir. 1996),  
 6 *as amended* (Aug. 6, 1996) (noting that the Ninth Circuit has not recognized a  
 7 cause of action for reverse confusion); *Marketquest Grp., Inc. v. BIC Corp.*, 862  
 8 F.3d 927, 932 (9th Cir. 2017) (holding that “reverse confusion is not a separate  
 9 claim that must be specifically pleaded, but instead is a theory of likely confusion”  
 10 and that “when reverse confusion is compatible with the theory of infringement  
 11 alleged in the complaint, ***a plaintiff need not specifically plead it***”) (emphasis  
 12 added). *Compare to Nasser v. Julius Samann, Ltd.*, No. 17-CV-863-BTM-MDD,  
 13 2020 WL 10457001, at \*2 (S.D. Cal. Aug. 28, 2020) (“[L]ikelihood of confusion  
 14 on its own is not a valid claim for relief.”). Therefore, Plaintiff’s new “cause of  
 15 action” amounts to a reshuffling of the same trademark infringement cause of  
 16 action stated in its original Complaint.

17 Importantly, Plaintiff’s amendments do not provide support for either of its  
 18 “reverse confusion” or “forward confusion” theories, regardless of whether those  
 19 theories could constitute causes of action. If anything, Plaintiff’s added allegations  
 20 just confirm that the only plausible theory under Plaintiff’s facts is one that  
 21 Defendants understood to be its confusion theory: reverse confusion. Furthermore,  
 22 Plaintiff’s proposed amendments do not address any of the arguments raised in  
 23 Defendants’ Motion for Judgment on the Pleadings with respect to its trademark  
 24 infringement claim, such as Plaintiff’s failure to specifically identify the goods and  
 25 services that it alleges have infringed on the I3 Marks, particularly where there  
 26 admittedly is no confusion, or the applicable presumption of laches. *See* Dkt. 54 at  
 27

13–19. These issues only further underscore the fact that Plaintiff’s attempt to amend its trademark infringement claim would be an exercise in futility.

Plaintiff’s other amendments also are futile. As noted above, Plaintiff’s amendments with respect to either Orpheus entity do not add any substantive allegations to the Complaint, and therefore do nothing to demonstrate that Plaintiff’s claim should survive Defendants’ Motion for Judgment on the Pleadings. Plaintiff also seeks to amend its final cause of action to allege that because it is registered to do business in California, it has a claim for infringement of trademarks that are registered with California. This is a non-sequitur. As set forth in Defendants’ Motion for Judgment on the Pleadings, Plaintiff cannot state a claim for trademark infringement under Cal. Bus. & Prof. Code §§ 14245 and 14250 because Plaintiff fails to plead that its **trademarks** are registered in the State of California. Cal. Bus. & Prof. Code § 14245(a)(1), (a)(3) (providing that “the owner of the registered mark” may file suit for infringement of “a **mark registered under this chapter**”) (emphasis added); Cal. Bus. & Prof. Code § 14250(a) (applying only to an owner “of a **mark registered under this chapter**”) (emphasis added). Whether Plaintiff is registered to “transact business” in California, or whether Plaintiff has federally registered marks, is utterly irrelevant as long as Plaintiff cannot show that it has any **trademarks** registered with the State of California. Therefore, the remainder of Plaintiff’s proposed amendments fail to address the defects already identified by Defendants.

If anything, the fact that Plaintiff’s proposed amendments fail resolve the issues set forth in Defendants’ Motion for Judgment on the Pleadings only emphasizes how necessary it is for the Court to hear Defendants’ Motion without further delay. *Compare Steckman v. Hart Brewing, Inc.*, 143 F.3d 1293, 1298 (9th Cir. 1998) (noting that, although there is a general rule that parties are allowed to amend their pleadings, it does not extend to cases in which any amendment would

1 be an exercise in futility or where the amended complaint would also be subject to  
 2 dismissal). If Plaintiff's motion truly were genuine, it would have waited for the  
 3 Court's ruling on the Motion for Judgment on the Pleadings to determine how to  
 4 remedy the issues, rather than concoct additions to the Complaint that fail to  
 5 address any of the arguments at issue in Defendants' pending Motion.

6 **3. Plaintiff Only Seeks to Amend the Complaint in Bad Faith,**  
 7 **and Such Amendment Will Prejudice Defendants**

8 Under Federal Rule of Civil Procedure 11, a party may not interpose an  
 9 amendment to its pleadings solely for delay or seek to amend claims that it cannot  
 10 in good faith support. The facts and analysis set forth above demonstrate that  
 11 Plaintiff clearly has brought its Motion with a dilatory motive (*i.e.*, delaying the  
 12 Motion for Judgment on the Pleadings and the progress of the case generally) and  
 13 has not proposed any amendments that demonstrate that it can support its claim in  
 14 good faith. Plaintiff failed to provide Defendants with a copy of the amended  
 15 complaint until the last business day before its deadline to file its Motion, and did  
 16 not attempt to engage in a proper L.R. 7-3 conference as required by the Central  
 17 District Local Rules and the Court's standing order. Nowhere did Plaintiff provide  
 18 any explanation for adjourning a hearing and inconveniencing the parties when  
 19 Plaintiff must have known its plan to amend and was aware of the deadline at least  
 20 as early as July 1, 2024, when Mr. Saadi appeared for the scheduling conference.  
 21 As Defendants suspected from Plaintiff's vague description of its intentions, none  
 22 of Plaintiff's amendments actually cure the deficiencies already identified in the  
 23 original Complaint.

24 Rather, it became clear from Plaintiff's own requests that Plaintiff filed its  
 25 Motion in an attempt to defer a determination on Defendants' Motion for Judgment  
 26 on the Pleadings. This bad faith motive was foreshadowed by Plaintiff's counsel  
 27 himself, given his explicit suggestion that Defendants stipulate to the amendment  
 28

1 of the Complaint (without being privy to the substance of that amendment) and  
 2 withdraw their Motion for Judgment on the Pleadings. *See* Lackman Decl., ¶ 8,  
 3 Ex. A. Such a delay would only serve to prejudice Defendants, whose Motion is  
 4 already pending, has been delayed already by Plaintiff's request, and would not be  
 5 undermined by any of Plaintiff's proposed amendments. That prejudice should  
 6 weigh in favor of denying Plaintiff's Motion. *Eminence Capital, LLC v. Aspeon,*  
 7 *Inc.*, 316 F.3d 1048, 1051 (9th Cir. 2003) (noting that out of all the *Foman* factors  
 8 prescribed by the Supreme Court, "the consideration of prejudice to the opposing  
 9 party . . . carries the greatest weight").

#### 10 **V. Conclusion**

11 Because the deficiencies in Plaintiff's Complaint are fatal, and they are not  
 12 and cannot be cured by Plaintiff's proposed amendments, Defendants respectfully  
 13 request that the Court deny Plaintiff's Motion for Leave to Amend.

14  
 15 DATED: AUGUST 2, 2024

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16  
 17  
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